

REMARKS

I. Claim Objections

The Examiner objected to claim 18 as the claim was labeled as "Original". The Examiner stated that the claim should be labeled as "Currently Amended".

The Applicant notes that claim 18 has been labeled as "Currently Amended" in response to this objection.

II. Claim Rejections - 35 USC §112

The Examiner rejected claims 1-20 under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner argued that claim 1 recites the limitation "the print on demand system performs the printing of the at least one publication and binding of the at least one publication block". The Examiner argued that there is insufficient antecedent basis for the phrase "the print on demand system", "the printing...and binding" and "the at least one publication block".

The Applicant notes that claim 1 has been amended to change "print on demand facilities" to "a print on demand system" in response to this rejection. The term "the printing ... and binding" has been changed to read as "printing and binding" in response to this rejection.

The Examiner rejected claims 5 and 9 as unclear in the use of the phrase, "the selection". Regarding claim 5, the Examiner stated "the selection" appears to relate back to claim 1, line 11 where the traveler makes a selection of a publication. Regarding lines 3-4 of claim 5, the Examiner argued that "the selection" now seems to refer to the product of the print on demand system, therefore, this term if different from the previous use and understanding, is unclear. Regarding claim 9, lines 2 and 3, the Examiner argued the use of the term

Patent Application Serial No. 10/694,138

"the selection" is unclear as to whether it relates back to "the selection" of claim 1 or "the selection" referring to the product of the print on demand system of claim 5, lines 3-4.

The Applicant notes that claims 5 and 9 have been amended to delete any reference to "the selection" in response to this rejection.

The Examiner argued that claim 8 refers to "an electronic interface" including "systems". The Examiner stated that it is unclear how a single interface includes a plurality.

The Applicant notes that claims 4, 8, 12, 15 and 20 have been amended to correct the typographical error and to refer to "communication system" in response to this rejection.

The Examiner argued that claim 13 recites, "the printing of the publication cover and the binding of the publication block". There is insufficient antecedent basis for "the printing", "the binding" and "the publication block".

The Applicant notes that claim 13 has been amended in response to this rejection.

The Examiner argued that claim 18 recites "receiving...orders from travelers using an electron interface" and "destinations that can be selected by the travelers for obtaining the purchase selection". The Examiner stated that it is unclear how a plurality of travelers uses a single interface for ordering and how a single selection is selected by a plurality of travelers and obtained at a plurality of destinations.

The Examiner argued that claim 19 refers to "the traveler's identity" (singular) whereas amended claim 18 only refers to a plurality of travelers, therefore, this term lacks insufficient antecedent basis.

The Applicant notes that claim 18 has been amended to refer to a singular traveler in response to this rejection.

The Examiner argued that claim 20 refers to "the electronic interface" including "kiosks,...systems or...appliances". The Examiner stated it is unclear how a single interface includes a plurality.

Patent Application Serial No. 10/694,138

The Applicant notes that claim 20 has been amended to refer to singular items in response to this rejection.

Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §112, second paragraph, rejections of claims 1-20 be withdrawn.

III. Claim Rejections - 35 USC § 103

Requirements for Prima Facie Obviousness

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness is clearly defined at M.P.E.P. §2142:

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

The U.S. Supreme Court ruling of April 30, 2007 (*KSR Int'l v. Teleflex Inc.*) states:

"The TSM test captures a helpful insight: A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. Although common sense directs caution as to a patent application claiming as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does."

"To facilitate review, this analysis should be made explicit."

The U.S. Supreme Court ruling states that it is important to identify a *reason* that would have prompted a person to combine the elements and to make that analysis *explicit*. MPEP §2143 sets out the further basic criteria to establish a *prima facie* case of obviousness:

1. *a reasonable expectation of success; and*

Patent Application Serial No. 10/694,138

2. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the Examiner (assuming there are no objections or other grounds for rejection) and of a *prima facie* showing by the Examiner of a *reason* to combine the references, an applicant is entitled to grant of a patent. Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that the basic criterion has been met.

Lundgren in view of Marsh and Ross

The Examiner rejected claims 1-20 under 35 U.S.C. §103(a) as being unpatentable over Lundgren (U.S. Patent Application No. 2003/0048471) in view of Marsh (U.S. Patent Application No. 2002/0061238) in view of Ross (U.S. Patent Publ. No. 5,465,213).

Regarding claims 1 and 3-20, the Examiner argued that Lundgren discloses providing aircraft passengers (i.e., travelers) with Internet access (citing Lundgren paragraph [0003]) whereby a "laptop computer or handheld computer" is connected "to an Internet web site for accessing a printing management application" where printing is performed "at a designated airport or at other locations designated by the user" (citing Lundgren paragraph [0007]). The Examiner argued that when selecting the printing and delivery options, including printing to printers at airports, the traveler is able to electronically select production facilities near the traveler's destination (citing Lundgren paragraph [0018]). The Examiner argued that the document is printed at the location specified by the traveler and is picked up "at the airport after the aircraft has landed" (citing Lundgren paragraph [0020]), thus the document is distributed to a pick-up facility as chosen by the traveler. The Examiner argued that Lundgren discloses that documents can be reviewed from the Internet (citing Lundgren paragraph [0004]). The Examiner argued that in this regard, it is obvious that documents that are reviewed from the Internet include previously published works, i.e., *publications*.

Patent Application Serial No. 10/694,138

The Examiner argued that therefore, publications are ordered from the Internet when the traveler provides user ID and billing information to the printing services application (citing Lundgren paragraph [0018]). The Examiner argued that Lundgren further discloses requiring “user identification (ID) and account information, including billing information such as a credit card number” be provided to the printing services application. The Examiner argued that this information is used to “track any print job initiated through the printing services application” (citing Lundgren paragraph [0018]). The Examiner stated that it is obvious that upon pick-up of the selection, the traveler’s identity would be authenticated in that the print order would be matched against the user ID and the billing information provided by the traveler when the selection was ordered. The Examiner argued that a remote pick-up location would be motivated to verify customer IDs and account information to ensure that print orders are released to the customer who ordered it. The Examiner argued that by teaching a system where on-board and remote printing operations of documents on the Internet (citing Lundgren paragraph [0004]) are performed for a fee, printing on demand is performed.

The Examiner admitted that Lundgren does not disclose *a catalog from which publications can be selected* or that the print on demand system prints a publication cover and binds the publication block of the selection from the catalog. The Examiner argued that Lundgren does disclose Internet access during a flight where travelers can access Internet services. The Examiner stated that this disclosure of Internet access during a flight obviously includes access to web based businesses.

The Examiner argued that Marsh discloses an online system for ordering and printing books on demand in which customers access via the Internet to view the books in the digital library (i.e., preview the books in a catalog or database), select and order the book and command the book to be printed, bound and trimmed (citing Marsh paragraph [0112]). The Examiner argued that Marsh also points to

Patent Application Serial No. 10/694,138

U.S. Patent No. 5,465,213 (Ross) as providing the teaching for accessing via the Internet to order a book to be printed on demand (citing Marsh paragraph [0112]).

The Examiner argued that therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included selecting and previewing publications to be printed from an online catalog, as disclosed by Marsh in the system disclosed by Lundgren, for the motivation of providing a convenient means of shopping. The Examiner stated that catalogs are an old and well known form of perusing items available for purchase that affords the customer convenience. The Examiner argued that by having provided Internet access to airline passengers, Lundgren foresaw the use of Internet shopping, and therefore, the obvious need for catalogs (citing Lundgren; paragraph [0003]): the system offers "Internet services while in-flight"). The Examiner argued that therefore, ordering anything from the Internet, including books to be printed on demand, is an obvious expansion of Lundgren's system.

The Examiner argued that Ross discloses a kiosk based system where a customer views "promotional sales information" (i.e., a catalog), purchases the book through system which initiates printing of the book and cover and finally binding (citing Ross col. 1; lines 55-C2; and line 32). The Examiner argued that Ross discloses that the "floor space required for the book manufacturing system...is somewhat larger than an ordinary office desk..." (citing Ross col. 2; lines 57-59). The Examiner argued that Ross also discloses using a WAN for a user to select a book where the WAN includes "satellite communications" (citing Ross col. 12; lines 38-56).

The Examiner argued that therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have expanded the system of Lundgren to include the print on demand system of Ross/Marsh wherein a book is ordered via the Internet and printed and bound with a cover since the claimed invention is merely a combination of old elements, and in the combination each element would have performed the same function as it did separately, and one of

Patent Application Serial No. 10/694,138

ordinary skill in the art would have recognized that the results of the combination were predictable.

The Examiner argued that specifically, it is predictable that the system of Lundgren, which discloses ordering and purchasing printed documents, when expanded to include the automatic thermal binding machine which is used to bind the text pages into the cover (citing Ross; col. 2; lines 27-29), would still perform the function of printing ordered documents. The Examiner argued that as the floor space requirements for the entire book manufacturing system of Ross is "somewhat larger than an ordinary office desk", it is obvious that the system of Lundgren would be capable of the expansion to include the added binding machine.

The Applicant respectfully disagrees with this assessment and notes that independent claims 1, 13 and 18 have been amended to include the limitation wherein the electronic interface is located on-board the vessel or in the terminal waiting area.

Regarding claim 1, the Applicant notes that claim 1 has been amended with the additional limitation of wherein the catalog is located on-board a vessel or in a terminal waiting area. This is disclosed in the Applicant's paragraphs [0008] - [0010] as follows:

[0008] In accordance with additional features of the present invention, methods for enabling a traveler to order a printed publication from public transport facilities while traveling to the traveler's destination and for producing and distributing publications are described. Methods in accordance with preferred embodiment of the invention can include providing a traveler access to a catalogue from which publications can be selected, wherein the traveler can review ordering information about available publications, and providing an electronic interface having a network connection to "publish-on-demand facilities, said electronic interface providing a means from which the traveler can select and order the preparation of at least one publication for pick-up by the traveler at a destination also selected by the traveler, wherein the selection and ordering can occur while the customer is awaiting travel, en-route on public transportation, or preparing to disembark public transportation.

[0009] A method for automatically producing a publication ordered by a traveler while the traveler is en-route and having the publications ready for pick-up by traveling customers after the customer's arrival at their destination or a destination

of their choosing can include receiving an electronic order for a publication over an electronic network from a traveler using a remote electronic interface, producing the publication using publish-on-demand system located near a destination selected by the traveler for pick-up of the publication, and distributing the publication to a pick-up facility located at the destination selected by the traveler for pick-up of the publication.

[0010] In accordance with methods of the present invention a traveling customer is provided with a catalog, which can be available while the customer is awaiting travel, while en-route, or while preparing to disembark from a vessel (e.g., a cruise ship). The catalog can be made available in printed form or through a communications network. The customer can review available reading material selections in the catalog. If the customer desires to make a publication purchase, the customer is provided an electronic interface from which to order a selection while awaiting travel, en-route, or preparing to disembark. Ordering can be provided through electronic interfaces such as kiosks and on-board communications (e.g., telephones, internet kiosks or personal wireless appliances). When completed, the order is automatically provided to and received by production facilities near the customer's scheduled or selected destination where the customer's order can be produced and then made available to the customer through on-site distribution facilities (e.g., stores or unattended kiosks) upon the customer's arrival at the destination.

Lundgren in view of Marsh and Ross does not disclose both of the limitations wherein the catalog *and* the electronic interface are located on a vessel or in a terminal waiting area. Additionally, the Applicant notes that claim 1 has been further amended to include the limitation wherein the destination selected by the traveler may include an *en-route stop* destination. Lundgren in view of Marsh and Ross does not disclose this limitation of a pick-up facility at an en-route destination. This limitation is disclosed in the Applicant's paragraph [0016] as follows:

[0016] A practical example of how the methods and systems of the present invention can be implemented is briefly illustrated with respect to the following scenario: Customer is flying from Rochester to Chicago with an eventual connecting flight to Los Angeles. While in the air, customer finds a catalog of books in the seatback pocket located in front of customer's seat. Looking through the catalog, customer finds a recent book of interest that customer would like to read during the long flight from Chicago to LA. Customer picks up the in-flight telephone from the seat-back location in front of him and calls a toll-free number to order the book. Through the in-flight telephone keypad, customer is able to order the book and provide billing information. When customer arrives in Chicago, a copy of the book, either newly produced or already available at the destination, is waiting to be picked up by the customer.

Regarding claim 9, the Applicant notes that claim 9 has been amended to include the further limitation wherein the pick-up facility includes one of the following: a terminal based store, a specialized vending machine, a terminal based kiosk, or a location near the traveler's arrival gate. This is disclosed in the Applicant's paragraph [0023].

Regarding claim 12, the Applicant notes that claim 121 has been amended to include the further limitation wherein the at least one publication may include one of the following: only selected chapters of a book or several publications in a single, bound publication. This is disclosed in the Applicant's paragraph [0024].

Regarding claims 13 and 18, the Applicant notes that claims 13 and 18 have been amended to include the further limitation wherein the pick-up facility includes one of the following: a terminal based store, a specialized vending machine, a terminal based kiosk, or a location near the traveler's arrival gate.

The Applicant submits that Lundgren in view of Marsh and Ross does not disclose all of the above amended limitations. Therefore, Lundgren in view of Marsh and Ross fails in the aforementioned *prima facie* obviousness test as each and every limitation of the Applicant's claims is not disclosed. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejections of claims 1 and 3-20 based on Lundgren in view of Marsh and Ross be withdrawn.

Regarding claim 2, the Examiner admitted that Lundgren/Marsh/Ross does not explicitly disclose that *the catalog can be made available in printed form*; however, the Examiner argued that it is obvious that airlines provide in-flight catalogs, such as "SkyMall". Therefore the Examiner argued, it is obvious, to expand the combined system of Lundgren/Marsh/Ross to include a printed catalog. The Examiner argued that one would be motivated to do so in order to minimize both the cost of the in-flight Internet access and the use of the laptop battery. The Examiner argued that by providing a printed catalog, the traveler is able to leisurely

Patent Application Serial No. 10/694,138

peruse the selections available then connect to the Internet just to make the purchase.

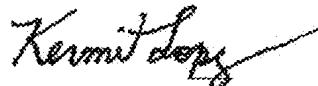
The Applicant respectfully disagrees with this assessment and notes that the argument presented above against the rejection of claim 1 applies equally against the rejection of dependent claim 2. As submitted above, Lundgren in view of Marsh and Ross does not disclose all of the Applicant's claim 1 limitations. Based on the foregoing, the Applicant respectfully requests that the 35 U.S.C. §103(a) rejection of claim 2 based on Lundgren in view of Marsh and Ross be withdrawn.

IV. Conclusion

In view of the foregoing discussion, the Applicant has responded to each and every rejection of the Official Action. The Applicant has clarified the structural distinctions of the present invention. Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §112 and 35 U.S.C. §103 based on the preceding remarks. Reconsideration and allowance of Applicant's application is also respectfully solicited. A Request for Continued Examination (RCE) under 37 CFR 1.114 is also submitted herewith, including the RCE fee of \$810.

Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact the undersigned representative to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,



Dated: July 7, 2008

Kermit Lopez
Attorney for Applicants
Registration No. 41,953
ORTIZ & LOPEZ, PLLC
P.O. Box 4484
Albuquerque, NM 87196-4484
Tel. 505-314-1312